SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

No. 71-441

MICHAEL EDWARD BENET JONES and
IMPERIAL CHEMICAL INDUSTRIES LIMITED, *Petitioners,*

v.

HERWARD A. VOGEL and MINNESOTA MINING AND
MANUFACTURING COMPANY, *Respondents*

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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Oct. 25, 1971

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Had petitioners only stated with accuracy the jurisdictional principles essential to a ready and adequate understanding of the points on which they seek this Court's consideration, petitioners themselves would have seen that this case presents no warrant for grant of a writ.

In bringing their question here concerning jurisdiction of U.S. District Courts to order discovery under 35 U.S.C. §24, petitioners choose to ignore what the Third Circuit Court of

Appeals, in the decision complained of, held to be "the basic nature of Section 24 discovery—namely that it is *ancillary* to the proceedings in the Patent Office." (4a.)*

So far do petitioners stray from the essential point at hand that nowhere is the term "ancillary" to be found in their Petition. The Petition, therefore, should be denied out of hand for lack of compliance with Court Rule 23(4).

Moreover, had petitioners but come to grips with the ancillary nature of jurisdiction in actions under 35 U.S.C. §24, their concern for collision of the decision below, with decisions of this Court setting "minimum contact" standards as a jurisdictional prerequisite over aliens, would have quickly dissolved. Ancillary jurisdiction already subsisted when this suit was brought. *Henry C. Rouse v. Annie Letcher,* 156 U.S. 47 (1895); *Stephen W. Carey v. Houston & Texas Central R. Co.,* 161 U.S. 115 (1896). As this Court stated in *Carey,* quoting from its earlier decision in *Rouse*—

> ". . . where jurisdiction would not obtain in an independent suit, an intervening proceeding may nevertheless be maintained as *ancillary* and supplemental *under jurisdiction already subsisting* . . ." [161 U.S. at 129.]

The decision of the Court of Appeals below is fully consistent with this long settled principle of ancillary jurisdiction. The Opinion carefully explains the basis upon which the United States District Court for the District of New Jersey possessed jurisdiction over petitioners, though aliens (4a):

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* Numerical references with letter suffix are to the appendix to the Petition. Emphasis and matter in brackets supplied throughout unless otherwise noted.

> "Personal jurisdiction, therefore, is acquired when the parties file interference applications in the Patent Office. The resulting 'interference' in the Patent Office is the primary proceeding. A motion for discovery of *documents* under Fed. R. Civ. P. 35 [sic], being necessarily limited to a *party* in the action already commenced in the Patent Office, requires no new or independent assertion of personal jurisdiction or issuance of summons. See *In re Natta,* 388 F. 2d 215, 220 (3rd Cir. 1968); *Natta v. Hogan,* supra at 691." [Emphasis by the Court.]

The ancillary jurisdiction found by the Court of Appeals below is no different, just because an alien litigant is involved, than that uniformly determined to exist in the numerous other Section 24 proceedings which have come before several of the Courts of Appeals. *In re Natta,* 388 F. 2d 215, 220 (3 Cir., 1968), cert. denied, *Montecatini Edison, S.P.A. et al v. E. I. duPont de Nemours & Co.,* 396 U.S. 836 (1969); *Natta et al v. Hogan et al,* 392 F. 2d 686, 690 (10 Cir., 1968); *Natta et al v. Zletz et al,* 379 F. 2d 615 (7 Cir., 1967), cert. denied, *Natta et al v. Zletz et al,* 395 U.S. 909 (1969). That is, those seeking the beneficence of the U. S. patent laws in the primary proceedings must, when called upon, submit to ancillary discovery in the interest of insuring "that the fundamental elements of procedural and substantive due process will be accorded to parties to patent interferences". *In re Natta,* supra, cert. denied, 396 U.S. 836.

Decision below not in conflict with decisions of this Court

Had petitioners only recognized the *ancillary* nature of the jurisdiction, they would have seen that the decision of the Court of Appeals below is not in conflict with this Court's decisions in *Hanson v. Denckla*, 357 U.S. 235 (1958), and *International Shoe Co. v. State of Washington*, 326 U.S. 310 (1945). Both of these decisions deal with due process requirements for *original* in personam jurisdiction of state courts over corporations of sister states. However, as the Court of Appeals below correctly recognized in expressly considering and reconciling *Hanson* and *International Shoe* (5a, note 7)—

> "Our reading of §24 does not imply that the Federal Rules of Civil Procedure create personal jurisdiction here. Rather, those Rules apply only to pre-existing jurisdiction which arises in the Patent Office, and to which this discovery is ancillary."

Decision below not in conflict with statutes

Contrary to petitioners' assertions the decision below is not in conflict with 35 USC §§146 and 293. Neither of these sections applies to proceedings ancillary to *pending* United States Patent Office proceedings. Section 146 deals only with *Court review* of decisions of the Patent Office Board of Patent Interferences on the question of priority (12a); and Section 293 relates to proceedings affecting the issued *patents* of non-resident patentees, *after* patent office proceedings have ended (13a).

If a corresponding statute provided specially for jurisdiction over aliens only in certain District Courts in discovery proceedings ancillary to *pending* Patent Office interferences,

then, of course, such statute would govern the proceedings here involved; but none exists. Hence, general jurisdictional statutes govern, and application of settled principles of general ancillary jurisdiction cannot conflict with special statutes not here involved.

Assertion of conflict between Federal law and decision below is afterthought.

The "conflicts" with decisions of this Court and with Acts of Congress, which petitioners now find, are born of petitioners' having lost in the Court of Appeals. Thus, until the Court of Appeals itself called attention to this Court's decision in *Hanson v. Denckla, supra,* and *International Shoe Co., supra* (5a, note 7), petitioners saw no need to cite these cases in either of the courts below as having any bearing on the instant litigation.

And it is plain why petitioners did not earlier advance their argument based on 35 U.S.C. §§146 and 293. Such an argument would, of course, acknowledge jurisdiction properly residing in the District of Columbia, whereas petitioners were striving to escape the discovery order of any and every court. As the Court of Appeals noted (3a):

> "[Petitioners'] reading of the statute would effectively remove non-resident aliens from the reach of discovery since no district of a United States court extends to foreign countries."

If they mounted an argument below postulating jurisdiction in the District of Columbia court, petitioners knew the discovery suit would wind up there. For as respondents had briefed the Court below:

> "Had [petitioners] ICI but suggested another district, [respondents] 3M would happily have cooperated to bring the matter before the court there."

It was only after the Court of Appeals below found ancillary jurisdiction to subsist in the New Jersey District Court that petitioners saw nothing to lose by their belated argument founded on the District of Columbia being the only appropriate forum.

Harm petitioners fear as consequence of decision below does not exist.

Great mischief will result from the decision below—petitioners say (Pet. 11)—because ancillary actions under 35 U.S.C. §24 against aliens will place an "unnecessary burden on all district courts throughout the land". The problem petitioners raise, were there any, "does not result essentially from the ancillary nature of discovery proceedings" under Section 24 (5a), but is instead attributable to the venue statute applicable to aliens, who, under 28 U.S.C. §1391(d), "may be sued in any district". Moreover, the Court of Appeals foresaw and in one sentence resolved any "far-reaching consequences" of its decision which petitioners would find (5a):

> "But an alien undoubtedly may move for a change in venue to a more convenient forum."

CONCLUSION

For the reasons stated above, it is submitted that the petition overlooks the very basis of jurisdiction found by the Court of Appeals below, and, moreover, raises no special and important question of law requiring resolution by this Court.

The petition should be denied.

Respectfully submitted,

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